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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/609,633

07/01/2003

Eric Wisniewski

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EXAMINER

NGUYEN, KHAI MINH

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/609,633	<b>Applicant(s)</b> WISNIEWSKI ET AL.	
	<b>Examiner</b> KHAI M. NGUYEN	<b>Art Unit</b> 2617	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 04 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/VINCENT P. HARPER/  
 Supervisory Patent Examiner, Art Unit 2617

1. Applicant's remarks/arguments have been given careful consideration. However, the arguments are not found persuasive because of the followings:

The rejection clearly states which reference teaches and the rationale as to why the examiner made a rejection based on combination of references. Applicant however has not provided any persuasive reasons why the examiner's finding is incorrect.

All prior art references as applied are from same analogous art, all references are the same filed of endeavor, dealing with the same problem or pertinent to the problem that Applicants are facing). The rejection clearly states which reference teaches and the rationale as to why the examiner made a rejection based on combination of references. Thus the combination of the teaching of (references) clearly met and fairly suggests the subject matter of claims 1 and 5. The claims basically recite an old combination of elements which under the "KSR" is not patentable, OR (specifically). The claims "were combination which only unites old elements with no change in their respective functions and which yield predictable results. Therefore the claimed subject matter would have been obvious, and therefore not patentable, KSC, 127S. Ct at 1740, 82 USPQ 2d at 1936

2. In response to Applicant's argument that the mediation server switches from the old used data exchange format to the new identified data exchange format. Applicant misinterprets the principle that claims are interpreted in light of specification. Although these arguments (pages 4-7) are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064.

In summary: the examiner interprets the claims in light of specification and given their broadest reasonable interpretation, but does not read the claims into the specification. It is the claims that define the claimed invention and it is claims, not specifications that are anticipated or unpatentable

3. Regarding claims 1 and 5, Applicant argues, on pages 2-8 of the remarks, that Sounviervi, Sehoh and Schuetze do not disclose, teach, or suggest "identifying at said mediation server a change in used data exchange format from a first data exchange format to a second identified data exchange format; and dynamically switching from first data exchange format to said second identified data exchange format".

Senoh clearly disclose a mediation server (item 2), and identifying at said mediation server (item 2) a change in used data exchange format from a first data exchange format to a second identified data exchange format ([0077] server 2 converts the format specification of the content from a first format to a second format if the format (first format specification) of the content stored on the content server 3 is not the same as the format (second format specification) required for viewing on the user terminal 1).

Schuetze clearly disclose dynamically switching from first data exchange format to said second identified data exchange format (col.3, lines 17-47 (for example, receiving electronic mail in a sender's format from a sender organization; a plurality of sending means, each sending means sending electronic mail in one of a plurality of distinct formats; gateway means associated with each of the sending means for converting the electronic mail into the format of the sending...determines the recipient's format from the identity of the recipient organization and routes the electronic mail through the gateway means to the sending means which can send mail in the recipient's format).

/Khai M Nguyen/  
Examiner, Art Unit 2617